

REMARKS

Further to the Advisory Action and the Notice of Appeal filed on November 5, 2004, Applicants request consideration and allowance of the above-identified application.

By this Amendment, claims 8, 15, 19 and 22 have been amended, and claims 23-25 have been added. Claim 1 was previously canceled. Accordingly, claims 2-25 are pending for consideration, of which claims 2, 5, 9, 12, 16 and 19 are independent. Applicants respectfully request reconsideration and allowance of all the pending claims.

Referring now to the final Office Action of May 5, 2004 claims 2, 3, 5, 6, 8-10, 12, 13, 15-17, 19, 20 and 22 are rejected under 35 U.S.C. §103(a), as being obvious in view of the combination of teachings of Cunningham et al. ('842), Zhang ('027) and Zhang et al. ('947). Also, claims 4, 7, 11, 14, 18 and 21 are rejected under 35 U.S.C. §103(a), as being obvious in view of the combination of teachings of Cunningham et al. ('842), Zhang ('027), Zhang ('947) and Nomoto et al. ('364). Applicants respectfully traverse each ground of rejection.

As the Examiner is aware, Pubic Law106-113, section 1000(a)(9), 113 Stat. 1501A-591, amended 35 U.S.C. 103 at paragraph (c), states:

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Further, as pointed out in MPEP Chapter 706.02(1)(1):

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues...The mere filing of a continuing application on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could

have been applied, in a rejection under 35 U.S.C. 103 in the parent application. (Emphasis added)

While MPEP Chapter 906.02(1)(2)(II) notes that:

Applications and references...will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assign to, the same person.

Accordingly, since the instant application was filed on July 20, 2000 as a continuing divisional application of U.S. Application No. 08/857,556, filed May 16, 1997, which is a divisional of U.S. Application No. 08/250,344, filed May 27, 1994, which is a continuation of U.S. Application No. 08/041,520, filed March 30, 1993 which is a continuation of U.S. Application No. 07/729,533 ('533), filed July 5, 1991 and since the '533 Application was properly assigned (copy previously provided) Semiconductor Energy Laboratory Co., Ltd. the following statement is hereby made:

U.S. Application No. 09/620,968, U.S. Patent 6,607,947 and U.S. Patent Application Publication 2003/0060027 (U.S. Application No. 10/289,313) were, at the time the invention of U.S. Application 09/620,968 was made, owned by Semiconductor Energy Laboratory Co., Ltd.

This clear and conspicuous statement is believed sufficient to remove the Zhang ('027) and Zhang et al. ('947) as prior art in the rejections under § 103 of record.

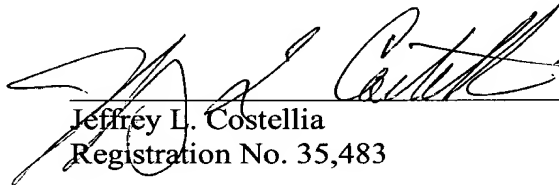
Consequently, Applicants respectfully submit that since neither the Cunningham et al. or Nomoto et al. references set forth any teachings about forming a silicon nitride by sputter deposition in an atmosphere comprising nitrogen, let alone nitrogen at 75 volume% or more as presently claimed, each of the rejections of record is now overcome. That is, a *prima facie* case of obviousness of claims 2-22 has not been set forth by either of the §103(a) rejections of record. Accordingly, Applicant respectfully requests withdrawal of each of those rejections.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Lastly, it is noted that a separate Extension of Time Petition (two month) accompanies this response along with an authorization to charge the requisite extension of time fee to Deposit Account No. 19-2380 (740756-2183). However, should that petition become separated from this Amendment, then this Amendment should be construed as containing such a petition. Likewise, any overage or shortage in the required payment should be applied to Deposit Account No. 19-2380 (740756-2183).

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise which could be eliminated through discussions with Applicants' representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

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